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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,142	03/12/2004	Gary Lee Butler	12929.1097US01	6797

58506 7590 04/06/2006

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EXAMINER

BOLES, DEREK

ART UNIT	PAPER NUMBER
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3749

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/800,142	Applicant(s) BUTLER ET AL.	
	Examiner Derek S. Boles	Art Unit 3749	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2006.  
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-35 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/30/04, 11/24/04, 4/21/05</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Drawings*

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the mounting of the system to an inner/outer surface of a heat generating device must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6-8, 19, 21, 22, 24, rejected under 35 U.S.C. 102(b) as being anticipated by Pierce (4,470,542) et al. See 5 for the panel, figs. 1-3 and col. 3, lines 16-48. Regarding claims 6 and 7, see 19. Regarding claim 8, see 11.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim(s) 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce in view of Bussjager (4,660,761). Pierce discloses all of the limitations of the claim(s) except for the material being condensation resistant. Bussjager discloses the presence of a material being condensation resistant. See col. 3, lines 48-55. Hence, one skilled in the art would find it obvious to modify the system of Pierce to include the material being condensation resistant of Bussjager for the purpose of mold prevention.

Regarding claim 4, Pierce discloses all of the limitations of the claim except for the panel being formed from a high temperature material using a vacuum molding, compression molding,

or casting process. However, since the applicant has failed to establish any criticality or synergistic results which are derived from the recited configurations, these limitations are considered a matter of obvious design choice. Thus, the applicant's design configurations would have been an obvious improvement to one of ordinary skill in the art with regard to the apparatus disclosed in Pierce.

Claim(s) 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce in view of design choice and in further view of Lyons et al. (6,170,481). Pierce in view of design choice discloses all of the limitations of the claim(s) except for the material including a ceramic fiber and a binder. Lyons et al. discloses the presence of material including a ceramic fiber and a binder. See col. 1, lines 36-45. Hence, one skilled in the art would find it obvious to modify the system of Pierce in view of design choice to include a material including a ceramic fiber and a binder of Lyons et al. for the purpose of increased durability.

Claim(s) 14-16 and 27-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce in view of Wade (6,260,548). Pierce discloses all of the limitations of the claim(s) except for the panel being integrally formed from a ceramic moldable material. Wade discloses the presence of a panel being integrally formed from a ceramic moldable material. See col. 2, lines 54-60. Hence, one skilled in the art would find it obvious to modify the system of Pierce to include the panel being integrally formed from a ceramic moldable material of Wade for the purpose of more appropriate heat transfer.

Claim(s) 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce in view of Wade and in further view of Bussjager. See claim 2, above.

Regarding claim 18, it has been held that the term "integral" is sufficiently broad to embrace constructions united by such means as fastening and welding. *In re Hotte*, 177 USPQ 326, 328 (CCPA 1973).

Claim(s) 20, 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce in view of Susany (5,915,374). Pierce discloses all of the limitations of the claim(s) except for the panel being formed using a vacuum molding. Susany discloses the presence of a panel being formed using a vacuum molding. See abstract. Hence, one skilled in the art would find it obvious to modify the system of Pierce to include the panel being formed using a vacuum molding of Susany for the purpose of ease of manufacture.

#### ***Response to Arguments***

Applicant's arguments filed 1/24/06 have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the panel is not in contact with the heat generating products) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, the hydro grate 1 is considered a panel in its broadest sense. Element 5 is also considered a panel. Element 25 is the first portion of the conduit in the panel. Regarding the objection to the drawings, there are no element numbers for the inner/outer surface of the heat generation device.

#### ***Conclusion***


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The provided references are representative of the state of the art that is applicable to

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the applicant's invention. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derek S. Boles at (571) 272-4872.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D.S.B.

  
**DEREK S. BOLES**  
**PRIMARY EXAMINER**  
**GROUP 3700**

3/30/06